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EXAMINER

GUTMAN, HILARY L

ART UNIT PAPER NUMBER

3612

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,693

Applicant(s)

SCHLECHT ET AL

Examiner

Hilary Gutman

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-65 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 and 32-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings were received on 7/174/2003. These drawings are acknowledged and approved by the examiner.

Specification

2. The disclosure is objected to because of the following informalities: on page 6, the paragraph beginning on line 10 discloses “outlet slit 12” and “rear windup window shade 10” but these phrases should instead be “outlet slit 10” and “rear windup window shade 12”. Also on page 7, the paragraph beginning on line 22 discloses “rear window 6 opening” but should be “rear window opening 6”. Appropriate correction is required.

Claim Objections

3. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Specifically, in claim 1, the last two lines recite “means 5”.

4. Claims 1, 6, and 9 are objected to because of the following informalities:

Art Unit: 3612

In claim 1, on lines 11-12, "an extended window shade web" should be "the window shade web when extended".

In claim 6, on line 2, "a" should be "the" and on line 3, "a" should be "the".

In claim 9, on line 3, "a" should be "the" (both occurrences).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6, 8-15 and 20-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, "seating", "connecting", and "guide" means are all recited. It should be noted that if one employs means plus function language in a claim, one must set forth in the specification and adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

Claim 5 recites the limitation "the mounting flange" in line 2. There is insufficient antecedent basis for this limitation in the claim. Specifically, this phrase is indefinite since no recitation of "a mounting flange" is previously recited.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 6, 8-9, 11-12, and 21-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ojima et al.

Ojima et al. disclose a windup window shade for regulating the entry of light through a window 1, 2 into the interior of a motor vehicle, having at least one windup shaft 113 (Figure 1), seating means 11 in which the windup shaft is rotatably seated, connecting means 16, with which the seating means are connected with each other, wherein the connecting means is arranged to be attached to the motor vehicle, at least one window shade web 12, which is connected to the windup shaft with one edge, at least one pair of guide means 14, each one of which is laterally spaced from and extends at least a distance away from a corresponding side of the window shade web and each of which contains at least one guide groove (Figure 16), a traction rod 13, which is connected with an edge of the window shade web 12 remote from the windup shaft 113 and whose ends, generally 17, are guided in the guide grooves (Figure 16), and a drive mechanism 15 for moving the traction rod along the guide rails and for driving the windup shaft. The windup shaft is tube-shaped and contains a spring drive 112, which is part of the drive mechanism. The window shade web 12 has been cut to approximate the window 1, 2. The guide means 14 are constituted by a guide rail 14, which contains an undercut groove (Figure 16). The guide means 14 extend in a manner corresponding to the associated edge of the window. The guide rail 14 is

Art Unit: 3612

provided with at least one continuous surface, generally an upper surface of the backwards "C" in Figure 16, whose generatrix is a straight line extending at right angles with respect to the longitudinal axis of the guide rail. The guide rail 14 has two surfaces, generally an upper surface and a lower surface of the backwards "C" in Figure 16, which are parallel to each other and whose generatrices are straight lines extending at right angles with respect to the longitudinal axis of the guide rail. The traction rod 13 consists of a center piece 131 and two end pieces 132, which can be moved in a telescope-like manner in relation to the center piece, wherein ends 17 of the end pieces are displaceably movable in the respective guide rail. The drive mechanism 15 has at least two drive members 18a, 18b, which are arranged drivingly between an electric drive motor 20 and the traction rod 13. The drive members 18a, 18b, are thrust members. The drive members are linearly-shaped members. The drive members have teeth on their exterior circumferential surface, generally of the rack and pinion type. The drive mechanism has a gear motor 20, on whose output shaft a gear wheel 19 is seated, which acts together in an interlocked manner with the drive members 18a, 18b.

Ojima et al. disclose the guide means being indirectly connected, at least in sections, with the seating means and the connecting means.

Ojima et al. lack the guide means being connected to the seating and connecting means to constitute a "pre-assembled" component.

However, since all of the components are connected after assembly or could be positioned and connected prior to assembly to assure that all of the components are properly sized and will fit within the vehicle, and since the "pre-assembled" limitation is apparently a process limitation, Ojima et al. is believed to satisfy all of the limitations of the claim as broadly

Art Unit: 3612

recited and interpreted. Moreover, as stated, one might pre-assemble the components initially outside of the vehicle to assure a proper fit therebetween before disassembling and re-assembling the components within the vehicle. Also, after assembly within the vehicle, the components are all either directly or indirectly connected and therefore “assembled” together thus satisfying the limitation.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojima et al. as applied to claim 22 above, and further in view of DE '966.

Art Unit: 3612

Ojima et al. lack guide tubes extending from the drive motor as far as an end of a respective guide rail.

DE '966 teach guide tubes 6, 7 for drive members 8, 9 which inherently extend from a drive motor 11 (Figures 10, 11, and 12) to an end of a guide rail 27 (Figure 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided guide tubes as taught by DE '966 upon the drive members of Ojima et al. in order to protect the drive members.

Allowable Subject Matter

12. The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference(s) to Ojima et al. Rejections based on the newly cited reference(s) are disclosed above.

13. Claims 3-5, 10, 13-15, 20, and 28-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496. The examiner can normally be reached on M-F 7:30am-4pm.

Art Unit: 3612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1134.

16. Any response to this action should be mailed to:

Assistant Commissioner for Patents

Washington, D.C. 20231

or faxed to:

(703) 305-3597, (for formal communications intended for entry)

or:

(703) 308-3297, (for informal or draft communications, please clearly label
"PROPOSED" or "DRAFT").

hlg
October 7, 2003

A handwritten signature in black ink, appearing to read 'D. Glenn Dayoan', with a date '10/14/03' written to the right.

D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600